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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,702	07/25/2000	Rex Macey	4897-2	6534

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ATLANTA, GA 30309-3915

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/625,702

Applicant(s)

MACEY, REX

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 11-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to Applicant's response to restriction requirement filed on January 23, 2004. Claims 1-53 are currently pending. The Examiner acknowledges applicant's election with traverse of Group II claims 6-10. Claims 1-5 and 11-53 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. Elected claims 6-10 have been examined. The response to restriction/election requirement and rejections are stated below.

#### ***Response to Restriction/Election Requirement***

2. Applicant's arguments in regards to the restriction requirements have been considered but are non persuasive for the reasons given below. As discussed in the last office action (Paper No. 6) the groupings of invention are distinct and separate for the reasons given therein even though they are not classified into a separate class or sub-class. These inventions require separate searches. The fact that the inventions are classified in the same class and subclass is not a test of "serious additional burden" imposed on the examiner. Hence the restriction of the claims is maintained.

#### ***Claim Rejections - 35 USC § 101***

3. The claims 6-10 of the invention are directed to non-statutory subject matter. Claim 6 is drawn to a retirement planning method for computing a possible future value of a portfolio of a plurality of joint investors that is not tied to any technological art. Similarly the dependent claims 7-10 are not tied to any technological art. Claims 6-10 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required

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in order to meet the statutory requirements. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Board Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 cites in the preamble “in a data processing system, a retirement planning method for computing a possible future value of a portfolio of a plurality of joint investors”. It is not clear if the claimed invention is a method or an apparatus. Claims 7-10 are rejected because they depend on the rejected claim 6. Clarification is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggioncalda et al (US Patent 6,012,044) in view of Dembo (US Patent 5,148,365) and further in view of Anderton et al (US Patent 5,930,760).

With reference to claim 6, Maggioncalda teaches in a data processing system, a retirement planning method for computing a possible future value of a portfolio, comprising the steps of: receiving user inputs comprising an initial value of the portfolio, a current age (See Maggioncalda Column 18 lines 44-52); computing a future value of the portfolio using a future time period, a predetermined rate of return, and the initial value of the portfolio (See Maggioncalda Column 1 lines 43-55, Column 2 lines 36-45 and Column 18 lines 62-67); and outputting the computed-future value of the portfolio (See Maggioncalda Column 2 lines 36-45).

Maggioncalda fails to teach the steps of determining an age of death of an investor based on the current age of the investor and simulation based on mortality tables, determining an age of death for a second investor using the same method, determining the greater age of death of the first and second investors by comparing the determined ages of death of the two investors and using the greater age of death of the first and second investors as a future time period.

Dembo teaches the steps of using simulation to determine the values of an output based on input values (See Dembo Column 2 lines 43-66). The simulation taught by Dembo is interpreted to include the steps of determining an age of death of an investor based on the current age of the investor and simulation based on a mathematical model, determining an age of death for a second investor using the same method.

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It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the steps taught by Dembo to the invention of Maggioncalda. The combination of the teaching taken as a whole suggests that users would have benefited from the objective method of determining an outcome based on input parameters.

Dembo and Maggioncalda combined fail to teach the step of using Mortality tables for determining an age of death and determining the time horizon for joint survivors by comparing the determined ages of death of the two investors and using the greater age of death of the first and second investors.

Anderton teaches the step of using Mortality tables for determining an age of death (See Anderton Abstract, Figure 2, Column 1 line 38- Column 2 line 5 and claims 1-14). The step of determining the time horizon for joint survivors by comparing the determined ages of death of the two investors and using the greater age of death of the first and second investors (especially in last-to-die types of insurance policies) is old and well known in the actuarial art. This step helps in designing annuities or insurance policies so that the last surviving beneficiary also receives benefits throughout their life.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the steps taught by Anderton and Dembo to the invention of Maggioncalda. The combination of the teaching taken as a whole suggests that users would have benefited from basing their decisions on scientifically compiled data like mortality tables.

With reference to claims 7-10, the features in these claims are either taught by the combined disclosures of Anderton, Dembo and Maggioncalda or are old and well known in the

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art. By adding these features to the invention of Maggioncalda the users would have benefited from further refining the decision making by refining the inputs to the system.

*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
May 14, 2004

 Richard Weisberger  
Primary Examiner